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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,957	09/10/2003	Tanveer R. Khondker	42P16654	5863
8791 7590 06/04/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER ABRAHAM, ESAW T				
ART UNIT		PAPER NUMBER		
2112				
MAIL DATE		DELIVERY MODE		
06/04/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,957

Applicant(s)

KHONDKER ET AL.

Examiner

ESAW T. ABRAHAM

Art Unit

2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18, 25 and 27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 9-18 is/are rejected.
7) ☒ Claim(s) 25 and 27 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 February 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Response to Applicant's argument/Amendment

1. In view of the amendment filed on 02/26/08, the Examiner withdraws all objections to the specification, drawing and claims.
2. In view of the applicant's argument filed on 02/26/08, the Examiner withdraws 112, 2nd rejections.

Response to Amendment

3. Applicant's arguments with respect to claims 1-8 have been considered (the claims are cancelled) but a new ground(s) of rejection under 112, 2nd and 101 non-statutory is made to reject claims 9-18, 25 and 27.

Status of Claims

4. Claims 1-8 are cancelled.
5. Claims 9-18, 25 and 27 are pending.

Claim Objections

6. Claims 25 and 26 are objected to because of the following informalities:
Claim 25, line 2, "input/output circuit" should recite ---input/output circuits---.
Claim 27 is at least rejected for its dependency, directly or indirectly, on the rejected claim 25 above.
Appropriate correction is requested.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 9-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claims 9 and 14 recite a "method of testing" comprising two steps.

The claim, if statutory, falls within the statutory class of "process."

"A process is... an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing." *Cochrane v. Deener*, 94 U.S. 780, 788 (1877). "Transformation and reduction of an article "to a different state or thing" is the clue to the patentability of a process claim that does not include particular machines." *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)).

There are cases suggesting that the lack of transformation is not determinative with respect to whether a claimed process is statutory. Those cases, however, involved inventions that at least used *machines* to transform *data*. For example, in *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1357 (Fed. Cir. 1999), set forth (citing *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994) (en banc)) that a § 101 inquiry is directed to the determination of whether the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been reduced to some practical application rendering it "useful." A claimed process that produces a useful, concrete, tangible result without pre-empting other uses of the mathematical principle falls within the scope of § 101. *AT&T Corp.* at 1358. The process held to be statutory in *AT&T Corp.*, however, required the use of switches and computers. See, e.g., *id.* at 1358 (AT&T's claimed process used "switching and recording mechanisms" to create a "signal" useful for billing purposes).

The "process" of instant claim 9 does not require any transformation and reduction of an article "to a different state or thing." Nor is the "process" tied to a particular machine that transforms data in such a way to produce a useful, concrete, and tangible result. Under a broad but reasonable interpretation of claims 9 and 14, the subject matter of the claim requires at most human thought and paperwork.

Claims 9 and 14 do not recite any particular way of implementing the steps. Claims 9 and 14 do not require any machine or apparatus to perform the steps. Claims 9 and 14 do not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Claim 9 does not call for any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. Claim 9 represents mere abstraction; i.e., a disembodied mathematical concept representing nothing more than an "abstract idea," which has not been reduced to some practical application that renders it "useful." As the Supreme Court has made clear, "[a]n idea of itself is not patentable." *In re Warmerdam*, 33 F.3d 1354, 1360 (quoting *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507, 22 L.Ed. 410 (1874)).

Claims 10-13 and 15-18 are at least rejected for their dependencies, directly or indirectly, on the rejected claims 9 and 14 above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9-18 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

Claims 9 and 14 recite a method of testing in the preamble, yet fails to recite any steps of testing in the body of claims 9 and 14. NOTE: claims 9 and 14 are a method of adjusting an integrated device, such as, "measuring a setup parameter for input/output circuit etc... other than testing.

Claims 10-13 and 15-18 are at least rejected for their dependencies, directly or indirectly, on the rejected claims 9 and 14 above.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esaw T. Abraham whose telephone number is (571) 272-3812. The examiner can normally be reached on M-F 8am-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EA

/Esaw T Abraham/
Examiner, Art Unit 2112
05/28/08